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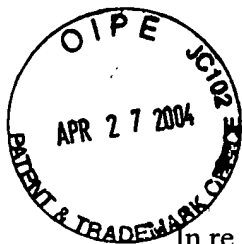
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BRANSTROM et al.

Appl. No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

Appeal No. 2001-1881

Art Unit: 1636

Examiner: I. Yucel

Atty. Docket No. 38644-175286

Customer No.

26694
PATENT TRADEMARK OFFICE

PETITION TO WITHDRAW ERRONEOUS NOTICE OF ABANDONMENT

U.S. Patent and Trademark Office
Mail Stop: Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

We received a Notice of Abandonment dated April 2, 2004 in the above-referenced application. The Notice indicated that the application was abandoned because a decision by the Board of Patent Appeals and Interferences was rendered on December 22, 2003 and the period for seeking court review of the decision had expired and there are no allowed claims. It is respectfully noted that a request for rehearing was timely filed on January 22, 2004, and a Denial of the Request was issued on March 1, 2004. Accordingly, pursuant to 37 CFR 1.304, the time for further Appeal expires May 1, 2004.

Serial No. 08/711,961

A copy of the Request for Rehearing, along with the date stamped receipt therefore, and a copy of the Denial, are filed herewith in support of the above.

Withdrawal of the Notice of Abandonment and consideration of the Request for Continued Examination filed herewith are respectfully requested.

It is believed that no extension of time or fee is required in connection with this petition. However, if any fees are due, please charge Deposit Account No. 21-0380 and advise accordingly.

Respectfully submitted,

Dated: April 27, 2004



Ann S. Hobbs

Registration No. 36,830

VENABLE

Post Office Box 34385

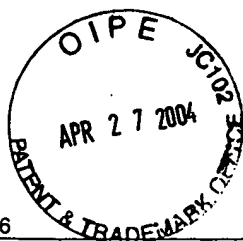
Washington, D.C. 20043-9998

Telephone: (202) 344-4000

ASH/cc

117637

Venable Filing Number



Attorney/CAA: Ann S. Hobbs, Ph.D.
 PTO Due Date: January 22, 2004
 Date Filed: January 22, 2004
 TM Official Gazette Date:

Atty. Docket No: 38644-175286

Re: Branstrom et al.,

Application No: 08/711,961

Patent No.:

Trademark:

Filing Date: September 6, 1996

Issue Date:

Trademark Reg. No:

Opposition/Cancellation No:

The following items were received from Venable, Washington, D.C., by the U.S. Patent & Trademark Office:

U.S. PTO FEES ENCLOSED

- ☐ Transmittal Letter
☐ Fee Transmittal Letter
☐ New U.S. Utility Application (pages of specification/claims)
☐ Formal Drawings (10 sheets, Figs.)
☐ Invention Declaration
☐ U.S. National Stage Application of PCT Application
☐ Translation of International Application
☐ New U.S. TM Application (specimens)
☐ Rule 53(d) Continued Prosecution Application
☐ Substitute Specification
☐ Rule 53(b) Continuation or Divisional Application (*attach copy of specification, claims, drawings & declaration*)
☐ Priority Document-Cert. Copy of Appln.#: ; Country
☐ Date Filed:
☐ Request for Continued Examination (RCE) under 37 CFR 1.114
☒ Request for Reconsideration
☐ Application Data Sheet
☐ Assignment w/Cover Sheet
☐ IDS w/ PTO SB/08 a/k/a PTO Form-1449 (references)
☐ Response
☐ ☐ Amendment/☐ Preliminary Amendment
☐ Petition/Request for Extension of Time (one mo. ext.)
☐ Notice of Appeal
☐ Appeal Brief (*in triplicate*)
☐ ☐ Reply Brief (*in triplicate*) ☐ Request for Oral Hearing
☐ Confirmation of Hearing Petition
☐ Issue Fee Transmittal
☐ Certificate of Correction
☐ Maintenance Fee Transmittal
☐ Power of Attorney
☐ Response to Notice to File Missing Parts
☐ Response to Notice to File Missing Requirements
☐ Response to Restriction Requirement
☐ Petition to Revive
☐ Sequence Listing - CDR Enclosed? ☐ Yes ☐ No
☐ Status Inquiry
☐ Request for Non-Publication
☐ Request to Rescind Non-Publication Request
☒ Terminal Disclaimer
☐ TM Statement of Use
☐ Extension of Time (mo. ext.)
☐ Declaration Under 8
☐ Declaration Under 8 and 15
☐ TM Renewal Application
☐ Notice of Opposition (*Please list all documents in Other section*)
☐ Amendment to Alleged Use
☐ Other: (*Please describe below*)



- ☐ Filing Fee
☐ Surcharge Fee
☐ Additional Claim Fee
☐ Recordation/Indexing Fee
☐ IDS Fee
☐ Extension Fee
☐ Notice of Appeal Fee
☐ Brief on Appeal Fee
☐ Oral Hearing Request Fee
☐ Petition Fee
☐ Issue Fee
☐ Publication Fee
☐ Maintenance Fee
☐ TM Statement of Use
☐ 8 Affidavit Fee
☐ 8 and 15 Affidavit
☐ TM Renewal Application Fee
☐ Notice of Opposition Fee
☐ TM Extension of Time Fee

Total Fees Paid

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☐ Check Number Attached
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☐ Yes ☐ No



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BRANSTROM et al.

Appl. No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

Appeal No. 2001-1881

Art Unit: 1636

Examiner: I. Yucel

Atty. Docket No. 38644-175286

Customer No.

26694

PATENT TRADEMARK OFFICE

REQUEST FOR RECONSIDERATION

U.S. Patent and Trademark Office
Mail Stop: U.S. Board of Patent Appeals and Interferences
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

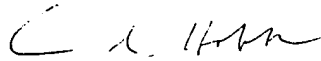
Applicants request reconsideration of the Decision on Appeal issued December 22, 2003, affirming the obviousness-type double patenting rejection over prior U.S. Patent No. 5,824,538. A Terminal Disclaimer was filed in the application on October 17, 2003, a copy of which is attached hereto. It is respectfully submitted that the Terminal Disclaimer overcomes the obviousness-type double patenting rejection. Accordingly, it is requested that the Board reverse the double patenting rejection and allow the patent to issue..

Serial No. 08/711,961

It is believed that no fees are required. However, if the Patent Office deems that any fees are necessary, authorization is hereby granted to charge any required fees

Deposit Account No. 22-0261

Respectfully submitted,



Ann S. Hobbs, Ph.D.
Registration No. 36,830

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P.O. Box 34385
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Telephone: (202) 344-4800
Telefax: (202) 344-8300

ASH/cc

115874

Venable Filing Number



Attorney/LA

Ann S. Hobbs

PTO Due Date:

Date Filed:

October 17, 2003

TM Official Gazette Date:

Atty. Docket No: 38644-175286

Re: Branstrom et al.

Application No: 08/711,961

Patent No.:

Trademark:

Opposition/Cancellation No:

Filing Date: September 6, 1996

Issue Date:

Trademark Reg. No:

The following items were received from Venable, Washington, D.C., by the U.S. Patent & Trademark Office:

U.S. PTO FEES ENCLOSED

- ☐ Transmittal Letter
☐ Fee Transmittal Letter
☐ New U.S. Provisional Application (pages of specification/claims)
☐ Formal Drawings (sheets, Figs.)
☐ Invention Declaration
☐ U.S. National Stage Application of PCT Application
☐ Translation of International Application
☐ New U.S. TM Application (specimens)
☐ Rule 53(d) Continued Prosecution Application
☐ Substitute Specification
☐ Rule 53(b) Continuation or Divisional Application (*attach copy of specification, claims, drawings & declaration*)
☐ Priority Document-Cert. Copy of Appln.#: ; Country
☐ Date Filed:
☐ Request for Continued Examination (RCE) under 37 CFR 1.114
☐ Request for Reconsideration
☐ Application Data Sheet
☐ Assignment w/Cover Sheet
☐ IDS w/ PTO SB/08 a/k/a PTO Form-1449 (references)
☐ Response
☐ ☐ Amendment/☐ Preliminary Amendment
☐ Petition/Request for Extension of Time (two mo. ext.)
☐ Notice of Appeal
☐ Appeal Brief (*In triplicate*)
☐ ☐ Reply Brief (*In triplicate*)/ ☐ Request for Oral Hearing
☐ Confirmation of Hearing Petition
☐ Issue Fee Transmittal and publication fee
☐ Certificate of Correction
☐ Maintenance Fee Transmittal
☐ Power of Attorney
☐ Response to Notice to File Missing Parts
☐ Response to Notice to File Missing Requirements
☐ Response to Restriction Requirement
☐ Petition to Revive
☐ Sequence Listing - CDR Enclosed? ☐ Yes ☐ No
☐ Status Inquiry
☐ Request for Non-Publication
☐ Request to Rescind Non-Publication Request
☒ **Terminal Disclaimer**
☐ TM Statement of Use
☐ Extension of Time (mo. ext.)
☐ Declaration Under 8
☐ Declaration Under 8 and 15
☐ TM Renewal Application
☐ Notice of Opposition (*Please list all documents in Other section*)
☐ Amendment to Alleged Use
☐ Other: (*Please describe below*)

- _____ Filing Fee
 _____ Surcharge Fee
 _____ Additional Claim Fee
 _____ Recordation/Indexing Fee
 _____ IDS Fee
 _____ Extension Fee
 _____ Notice of Appeal Fee
 _____ Brief on Appeal Fee
 _____ Oral Hearing Request Fee
 _____ Petition Fee
 _____ Issue Fee
 _____ Publication Fee
 _____ Maintenance Fee
 _____ TM Statement of Use
 _____ 8 Affidavit Fee
 _____ 8 and 15 Affidavit
 _____ TM Renewal Application Fee
 _____ Notice of Opposition Fee
 _____ TM Extension of Time Fee



\$130.00 Total Fees Paid

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☐☒

Check Number

Attached

Charge Deposit Account No. 22-0261*

☒ Yes ☐ No



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BRANSTROM et al.

Appl. No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

Art Unit: 1636

Examiner: I. Yucel

Atty. Docket No. 38644-175286

Customer No.

26694
PATENT TRADEMARK OFFICE

SUBMISSION OF TERMINAL DISCLAIMER

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Enclosed is a Terminal Disclaimer for the above-identified patent application.

Please charge the required fee and any other fee that may be necessary to Deposit

Account No. 22-0261.

Respectfully submitted,

Ann S. Hobbs, Ph.D.
Registration No. 36,830

VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 962-4800
Telefax: (202) 962-8300

ASH/cc

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**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A PRIOR PATENT**Docket Number (Optional)
38644-175286

In re Application of: Arthur A. Branstrom et al.

Application No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

The owner*, Government of the United States, as represented by the Secretary of the Army of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,824,538. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☒ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney of record.

Elizabeth Arwine

Signature

9/3/03

Date

ELIZABETH ARWINE

Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Certification under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.





UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/711,961	09/06/1996	ARTHUR A. BRANSTROM	003/030/SAP	9506

7590 03/01/2004
MCMR-JA (JOHN MORAN)
US ARMY MEDICAL RESEARCH
AND MATERIEL COMMAND
FORT DETRICK
FREDERICK, MD 217025012



EXAMINER

YUCEL, IREM

ART UNIT PAPER NUMBER

1636

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

STAFF JUDGE ADVOCATE
FORT DETRICK, MD
2004 MAR -3 AM 7:40

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33



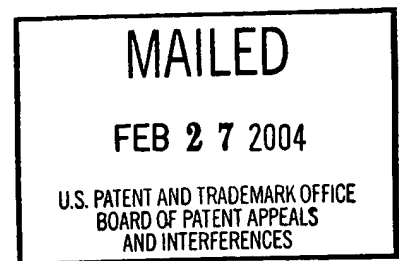
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ARTHUR A. BRANSTROM, DONATA R. SIZEMORE,
and JERALD C. SADOFF

Appeal No. 2001-1881
Application No. 08/711,961

ON BRIEF



Before WINTERS, ADAMS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

REQUEST FOR REHEARING

On December 22, 2003, this panel issued a decision on appeal in which we summarily affirmed the obviousness-type double patenting. In that decision, we noted:

Even though we now have new claims 56, 57, 59-62 and 64-65 before us, appellants do not dispute that the new claims are subject to the obviousness-type double patenting rejection affirmed in the May Decision on Appeal. Appellants' only remarks were that they would file a Terminal Disclaimer, which has not been filed at this time. See Paper No. 29. Under these facts, we summarily affirm the obviousness-type double patenting rejection as to newly entered claims 56, 57, 59-62 and 64-65.

Decision on Appeal mailed December 22, 2003, page 2.

In the Request for Reconsideration, Appellants request reconsideration of the above decision on the grounds that a terminal disclaimer was filed in the application on October 17, 2003. Appellants have also attached a copy of the Terminal Disclaimer to the Request for Reconsideration. The function of the Board in the ex parte context, however, is to review rejections. The Board does not perform examining functions in the first instance, and a terminal disclaimer must be proffered to the relevant Technology Center and the examiner, rather than to the Board. See MPEP § 1490.

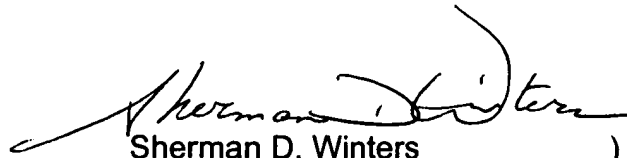
Moreover, an obviousness-type double patenting rejection of claim 45-55 was before us in the Decision on Appeal mailed May 30, 2003, and as appellants had not argued the merits of the rejection, and as a terminal disclaimer had not been filed, that rejection was also affirmed. The Request for Reconsideration does not provide an explanation as to why the terminal disclaimer filed October 17, 2003, after our first decision on appeal, was timely filed.¹ Accordingly, appellants request for rehearing is denied.

¹ See In re Deters, 515 F.2d 1152, 1157, 185 USPQ 644, 48 (CCPA 1975) ("Since no terminal disclaimer was timely filed, we sustain . . . [the obviousness-type double patenting] rejection."); Cf. In re Jursich, 410 F.2d 803, 807, 161 USPQ 675 (CCPA 1969), footnotes and citations omitted, ("The record shows that appellants' assignee filed a terminal disclaimer in the Patent Office after the board decision which the board refused to consider because it was not timely presented or considered by the examiner. Appellants assign error in that action by the board, arguing that the terminal disclaimer 'eliminated the double patenting issue in the present case.' However accurate that statement may be, we cannot consider the disclaimer here. . . .").

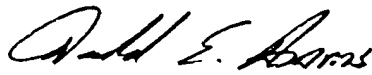
CONCLUSION

For the reasons set forth above, Appellant's Request for Rehearing is denied.

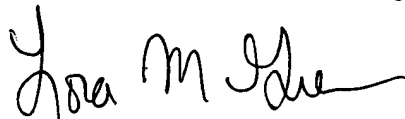
REQUEST FOR REHEARING-DENIED



Sherman D. Winters
Administrative Patent Judge



Donald E. Adams
Administrative Patent Judge



Lora M. Green
Administrative Patent Judge

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) BOARD OF PATENT
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MCMR-JA John Moran
US Army Medical Research
And Material Command
Fort Detrick
Frederick, Maryland 21702-5012